

SECTION: REMARKS

This reply is submitted pursuant to 35 U.S.C. §132 and 37 C.F.R. §1.111. The Office Action was carefully considered by the undersigned attorney and applicant. Reconsideration of the application is respectfully requested.

1. Summary of the Office Action.

The restriction and election were indicated.

Claims 1-37 were pending.

Of the above claims 21-37 are withdrawn from consideration.

Claim 20 is rejected under 35 U.S.C §101 for double patenting.

Claims 1-19 stand rejected under 35 U.S.C §102(b) over Kim (5,993,920)

Claims 1-19 stand rejected under 35 U.S.C §102(b) over Scarborough (5,803,964)

Claims 1-19 stand rejected under 35 U.S.C §102(b) over Prior Art submitted by the applicant (Metalcrete FLORUNDUM).

2. Discussion.

Applicant acknowledges the election.

Claim Rejection - 35 USC §112, Second Paragraph

Claim 20. This claim was rejected under 35 USC §112, second paragraph. Claim 20 is canceled without prejudice.

Claim Rejections - 35 USC §102

Claim 1. This claim was rejected under 35 USC §102(b) as being anticipated by Kim, Scarborough, and the Metalcrete Florundum publication. The claim is amended to patentably distinguish and limit over each of the applied references by defining the invention to require a **silica** fine aggregate, a **marble** honable aggregate, and constituent **proportions** of 25-35 cement, 15-25 fine aggregate, and 40-60 honable aggregate percent by weight. This combination of characteristics is not shown, suggested or made obvious by the applied references, either alone or in combination with each other.

Kim discloses an **artificial marble**. In the Background (column 1 lines 24-27) Kim discloses that prior art artificial marbles contain small real marble aggregates for pattern purposes. Kim does not specifically disclose that real marble aggregate is actually used in the subject composition. In contrast, the Kim composition is patterned by a molding plate (column 2, lines 31-36). Further, although real marble may be inherently honable as the Examiner held, Kim explains that prior artificial marbles are low strength. Applicant submits that this teaches away from considering these aggregates honable. Kim fails to disclose or suggest a **silica** fine aggregate. And, Kim fails to disclose the now claimed **proportions** (Kim fails to disclose any proportions of constituents).

Scarborough discloses a **sprayable concrete** including cement, fine aggregate and large aggregate. Referring to column 8, lines 6-50, for sprayability, the mixture contains 21 percent cement, 58 percent fine aggregate (27% small size marble dust and 30% sand), and 15 percent graded aggregate (6% No. 2 and 9% No. 4). This predominantly **smaller** aggregate mixture differs substantially from applicant's now claimed predominantly **larger** aggregate mixture. Additionally, Scarborough does not disclose any **marble** honable aggregate, which the claim has now been amended to recite.

Metalcrete Florundum discloses a floor hardener containing cement and an apparently honable marble aggregate. Applicant assumes that the hardener contains fine aggregate. Metalcrete Florundum does not disclose or suggest applicant's now claimed **proportions** of constituents, nor does it disclose or suggest the use of **silica** fine aggregate.

These differences are patentably significant because the amended elements relate to advantages the invention has in terms of use as a dry shake, and providing a uniquely hard surface and simultaneously decorative surface. It is submitted that this amendment clearly indicates a narrower interpretation than that of the original claim, which interpretation patentably avoids the applied art. Withdrawal of the rejection is requested. **Claims 2, 5, 7 and 9** are canceled in view of this amendment.

Claim 18. This dependent claim stands rejected under 35 USC 102(b) over Kim, Scarborough, and Metalcrete Florundum. This dependent claim defines the invention to require a particular quantitative mixture of particle sizes for the honable aggregate, namely about 40 percent No. 0,

about 6 percent No. 1, and about 4 percent No. 2. This composition is not shown or suggested in the applied references. Kim and Metalcrete Florundum discloses no gradation of honable aggregates. Scarborough discloses 6 percent No. 2 size chips. Larger No. 4 particles are added. Some No. 0 are added, but the amount is unknown. No No. 1 are disclosed. Applicant's particular mixture provides optimum aesthetic qualities to a high performance (i.e. hard) floor. This dependent claim is submitted to be patentable for this reason in addition to those urged with respect to its base claim (amended claim 1) above.

Claim 38. This new independent claim is directed to a composition having all of the constituents and characteristics of amended claim 1 and dependent claim 18. In addition, it recites the function of each constituent. As was discussed above with respect to each of these claims independently, the applied references clearly do not show, suggest or render obvious the **combination** of all of the elements. Additionally, although Kim discloses the use of stone or concrete powder, as is clear from claims 1 and 2 thereof, the stone and concrete serve the same purpose in the composition as opposed to separate functions in applicant's invention (i.e. concrete "adherence" and fine aggregate "hardening").

In summary, the differences between this new claim and the applied references directly relates to advantages which the invention has and the claim is therefore believed to be patentable.

Remaining Claims. The remaining dependent claims each adds at least one limitation to the elements of its base claim, and is therefore deemed to be allowable with such base and any intervening claim, at least for this reason. Some of the claims were amended in view of the amendments and cancellations above.

3. Conclusion.

The claims pending after this amendment are believed to be patentable for the reasons stated above. The amendments are believed to be supported by the specification, claims and drawings as filed. It is believed that this case is now in a condition for allowance. Reconsideration and favorable action are respectfully requested.

Should the Examiner believe that telephone communication would advance the prosecution of this case to finality, she is invited to call at the number below.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time under 37 CFR 1.136(a), provided a Petition is not submitted separately.

Please charge any fee due not paid by a check or credit card provided herewith, and/or charge any underpayment in any fee, and/or credit any overpayment in fee, to Deposit Account No. 19-2381.



Any fees due are calculated as follows:

Number Fee

TOTAL claims remaining over that previously paid for: None \$0

INDEPENDENT claims remaining over that previously paid for: None \$0

SUM claim fees: \$0

EXTENSION fees: \$0

OTHER fees: \$0

TOTAL AMOUNT (if any) \$0

☐ Paid by enclosed check.

☐ Paid by enclosed Credit Card Payment Form(s) PTO-2038.

Respectfully submitted,

Joel D. Skinner, Jr.
Reg. No. 33,786

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Skinner and Associates
212 Commercial Street
Hudson, Wisconsin 54016
Tel.: (715) 386-5800
FAX: (715) 386-6177

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